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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,622	12/01/2000	William Bricker Chamberlin III	3043	4179

7590 03/01/2004

THE LUBRIZOL CORPORATION
Patent Department - Patent Administrator
29400 Lakeland Boulevard
Wickliffe, OH 44092-2298

EXAMINER

HUYNH, HAI H

ART UNIT	PAPER NUMBER
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3747

DATE MAILED: 03/01/2004

25

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/727,622

Applicant(s)

CHAMBERLIN ET AL.

Examiner

Hai H. Huynh

Art Unit

3747

--The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

THE REPLY FILED on February 11, 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1,3-9 and 13-41.Claim(s) withdrawn from consideration: 2,10-12 and 42-44.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: it would have been an obvious matter of design choice to use the low-phosphorus lubricating oil composition on the camless engine to reduce wear and exhaust gas emissions.

DETAILED ACTION

Claims 1, 3-9, and 13-41 are in the case.

Claims 2, 10-12, and 42-44 have been withdrawn from consideration.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3-9, and 13-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schechter (5,456,222) in view of Manka et al (5,834,407).

Schechter teaches a method for operating a camless internal combustion engine. Manka et al teach a low-phosphorus or phosphorus-free lubricating oil composition for an engine containing an extreme-pressure additive comprised of metal and phosphorus, provided the amount of phosphorus contributed to the low-phosphorus or phosphorus-free lubricating oil composition by the extreme-pressure additive does not exceed about 0.08% by weight based on the weight of the low-phosphorus or phosphorus-free lubricating oil composition (See col. 10, 15 and 28). It would have been an obvious matter of design choice to use the low-phosphorus lubricating oil composition on the camless engine to reduce wear and exhaust gas emissions because of the low amount of phosphorus.

Response to Arguments


2. Applicant's arguments filed on February 11, 2004 have been fully considered but they are not persuasive.

3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the low-phosphorus lubricating oil composition in the electro-hydraulic actuator of a camless engine in order to reduce wear, noise and emissions.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai H. Huynh whose telephone number is (703) 306-9183. The examiner can normally be reached on Monday through Thursday from 7:30 am to 6:00 pm.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


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